



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,136	08/26/2004	Shyam K. Gupta		5135

34820 7590 04/15/2008  
SHYAM K. GUPTA  
BIODERM RESEARCH  
5221 E. WINDROSE DRIVE  
SCOTTSDALE, AZ 85254

EXAMINER
----------

HELM, CARALYNNE E

ART UNIT	PAPER NUMBER
----------	--------------

1615

MAIL DATE	DELIVERY MODE
-----------	---------------

04/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/711,136	<b>Applicant(s)</b> GUPTA, SHYAM K.	
	<b>Examiner</b> CARALYNNE HELM	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,6,7 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,6,7 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

To summarize the previous election, applicant elected the species with a carrier base that is a solid cosmetic stick in the reply filed on November 16, 2007. No arguments were presented distinctly and specifically point out the supposed errors in the restriction requirement, so the election was treated as an election without traverse (MPEP § 818.03(a)). The restriction requirement is deemed proper and thereby made FINAL.

The claims currently under examination are 1, 4, 6-7, and 13-17.

### ***Response to Arguments***

Applicants' arguments, filed January 8, 2008, have been fully considered but are moot in view of new grounds of rejection. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 contradicts the independent claim from which it depends (claim 1). Claim 1 requires the presence of only a zinc zeolite and a carrier base in the composition. The limitation

Art Unit: 1615

of claim 4 recites an embodiment where zinc zeolite constitutes 100% of the composition and is in opposition to its independent claim which requires that at least some carrier base is present.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6-7, 13-14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. (U.S. Patent No. 5,723,110)

Yamamoto et al. disclose a solid deodorant (cosmetic) stick composition with a zinc ion carrying zeolite (zinc zeolite) at 15% (see column 12 lines 10-12 and 27-30, example 56; instant claim 1, 4, 7, 13, and 16). Further, Yamamoto et al. also disclose additional components in the stick carrier base that include squalane, an oil/emollient/moisturizer component, and octamethylcyclotetrasiloxane, a silicone (see column 5 lines 10-12, column 6 line 9, column 8 lines 18 and 42, and example 56; instant claims 6 and 14). Thus claims 1, 4, 6-7, 13-14, and 16 are unpatentable over Yamamoto et al.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1615

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The four factual inquiries of *Graham v. John Deere Co.* have been fully considered and analyzed in the rejections that follow.

Claims 1, 6, 14-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. in view of Esser (U.S. Patent No. 5,932,199).

Yamamoto et al. teach a solid deodorant (cosmetic) stick composition with a zinc ion carrying zeolite (zinc zeolite) (see example 56; instant claims 1, 6, and 14). Yamamoto et al. do not specifically teach the inclusion of glycerin in the solid stick cosmetic form. Esser teaches an antiperspirant (deodorizing composition) that includes a moisturizing cream with a humectant (see column 1 lines 57-67). Esser goes on to teach that humectants are well known in the art for increasing water content in the top layer of skin and cite glycerol (glycerin) as a particularly preferred variety (see column 2 lines 25-27, 29-30; instant claims 15 and 17). Further, Esser exemplifies glycerol (glycerin) in a cosmetic stick formulation of the invention (see example 1 and example 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use glycerol (glycerin) in the invention of Yamamoto et al. since its utility in solid cosmetic stick compositions was known. Therefore claims 1, 6, 14-15, and 17 are obvious over Yamamoto et al. in view of Esser.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 7, 13, and 16 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 8 of copending Application No. 10/710011. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a composition that contains a zinc zeolite and a solid cosmetic stick carrier. Thus instant claims 1, 7, 13, and 16 are unpatentable over claims 1 and 8 of copending Application No. 10/710011.

Claims 1, 7, 13, and 16 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, and 9 of copending Application No. 11/760466. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a composition that contains a zinc zeolite and a solid cosmetic stick carrier. Thus instant claims 1, 7, 13, and 16 are unpatentable over claims 1 and 8 of copending Application No. 10/710011.

Art Unit: 1615

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

### ***Conclusion***

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARALYNNE HELM whose telephone number is (571)270-3506. The examiner can normally be reached on Monday through Thursday 8-5 (EDT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Caralynne Helm/  
Examiner, Art Unit 1615

/Michael P Woodward/  
Supervisory Patent Examiner, Art Unit  
1615